



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

EX PARTE HICKMAN *et al.*

Application for Patent

FOR

**AUTOMATIC ELECTRONIC DOCUMENT FILING SYSTEM, METHOD, AND
ARTICLE OF MANUFACTURE**

Serial No. 09/625,300

Filed 07/24/2000

Examined by KYLE R. STORK Art Unit 2178

APPEAL BRIEF

CERTIFICATE OF MAILING

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12/01/2009 CCHAU1 00000027 09625300

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I. REAL PARTY IN INTEREST

The real party in interest is G&H Nevada-Tek.



II. RELATED APPEALS AND INTERFERENCES

The following appeals may be related.

| Atty. Dock. No. | USSN | Patent No. | Remarks |
|-----------------|------------|------------|--|
| HSC1P001.US01 | 09/648,715 | 7,082,439 | BPAI Decision 1/27/06 with Examiner reversed. Patent issued. |
| HSC1P003.US01 | 09/488,862 | n/a | BPAI Decision 3/9/05 with Examiner reversed. Prosecution reopened by Examiner. BPAI Decision 6/19/08 with Examiner reversed. Prosecution reopened by Examiner. |
| HSC1P004.US01 | 09/488,863 | n/a | BPAI Decision 3/19/08 with Examiner affirmed. CAFC Decision 4/3/09 affirmed without comment. |
| HSC1P005.US01 | 09/488,962 | n/a | On Appeal and awaiting decision by the BPAI |

Copies of the BPAI and CAFC decisions are provided in Appendix X – Related Proceedings

III. STATUS OF THE CLAIMS

Claims 1, 5, 6, 10-32 and 36 are pending and are the subject of this appeal.

Claims 2-4, 7-9, 33-35, 37-41 have been canceled.

IV. STATUS OF THE AMENDMENTS

All amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Certain embodiments, set forth by way of example and not limitation, have been claimed in the subject application. Support for the claim elements can be found generally throughout the specification and drawings with examples. However, such examples are not exhaustive and are merely provided to facilitate in the claim construction process.

In the embodiment of claim 1, set forth by way of example and not limitation, an automated electronic filing system [See, for example: Fig. 1, ref. 10; page 6, lines 6-11; page 7 lines 3-12] includes a web server [See, for example: Fig. 1, ref. 14; page 6, lines 3-11; page 6, line 26 to page 7, line 2; page 7, line 13 to page 8, line 23] coupled to a wide area network [See, for example: Fig. 1, ref. 12; page 6, lines 3-11]; a receiving agency server [See, for example: Fig. 1, ref. 20; page 6, lines 3-11; page 6, line 26 to page 7, line 2; page 7, line 13 to page 8, line 23] separate from said web server and coupled to said wide area network such that it is capable of communication with said web server; a client machine [See, for example: Fig. 1, ref. 16; page 6, lines 3-11; page 6, line 26 to page 8, line 23] separate from said web server and said receiving agency server and coupled to said wide area network for communication with said web server, such that said web server serves as an interface [See, for example: Fig. 1, ref. 14; page 7, line 20] to said receiving agency server, said client machine providing information [See, for example: Fig. 1, ref. 22; page 7, line 20-31] to said web server forming at least a part of an electronic document to be filed with said receiving agency server by said web server in a manner that said web server serves as an interface to said receiving agency computer, said electronic document filed for further processing by a receiving agency associated with said receiving agency server in accordance with a procedure for which said receiving agency is in some manner responsible; and wherein said web server automatically produces at least a portion of said electronic document in response to a selection [See, for example: page 8, line 11-15] originating from said client machine.

In the embodiment of claim 21, set forth by way of example and not limitation, a method for electronically filing documents over the Internet [See, for example: Fig. 1, ref. 12; page 6, lines 3-11] via an intermediary web server [See, for example: Fig. 1, ref. 14; page 6, lines 3-11; page 6, line 26 to page 7, line 2; page 7, line 13 to page 8, line 23] includes prior to the following

acts, storing data useful for populating an HTML based form [See, for example: Fig. 2, ref. 30a; page 8, line 24 to page 9, line 33] on a web server coupled to the Internet; providing access to said HTML based form by a client machine [See, for example: Fig. 1, ref. 16; page 6, lines 3-11; page 6, line 26 to page 8, line 23] which is separate from said web server and which is coupled to the Internet; at least partially automatically filling in said form [See, for example: Fig. 2, ref. 30b; page 8, line 24 to page 9, line 33] on said web server with suitable data selected from said data useful for populating said HTML based form based upon input from said client machine; verifying on said web server completeness of said form and information of said form [See, for example: Fig. 2, ref. 30c; page 8, line 24 to page 9, line 33] based upon stored heuristics; and submitting [See, for example: Fig. 2, ref. 30e; page 8, line 24 to page 9, line 33] by said web server said form to a receiving agency over the Internet.

In the embodiment of claim 27, set forth by way of example and not limitation computer readable media including code segments for electronically filing documents over the Internet [See, for example: Fig. 1, ref. 12; page 6, lines 3-11] via an intermediary web server [See, for example: Fig. 1, ref. 14; page 6, lines 3-11; page 6, line 26 to page 7, line 2; page 7, line 13 to page 8, line 23] includes a code segment for storing data useful for populating an HTML based form [See, for example: Fig. 2, ref. 30a; page 8, line 24 to page 9, line 33] on a web server coupled to the Internet; a code segment providing access to said HTML based form by a client machine [See, for example: Fig. 1, ref. 16; page 6, lines 3-11; page 6, line 26 to page 8, line 23] which is separate from said web server and which is coupled to the Internet; a code segment at least partially automatically filling in said form [See, for example: Fig. 2, ref. 30b; page 8, line 24 to page 9, line 33] on said web server with suitable data selected from said data useful for populating said HTML based form based upon input from said client machine; a code segment verifying on said web server completeness of said form [See, for example: Fig. 2, ref. 30c; page 8, line 24 to page 9, line 33] and information of said form based upon stored heuristics; and a code segment submitting [See, for example: Fig. 2, ref. 30e; page 8, line 24 to page 9, line 33] by said web server said form to a receiving agency over the Internet.

In the embodiment of claim 31, set forth by way of example and not limitation, an automated electronic filing system for use in electronic prosecution of trademark applications includes a web server [See, for example: Fig. 1, ref. 14; page 6, lines 3-11; page 6, line 26 to

page 7, line 2; page 7, line 13 to page 8, line 23] coupled to a wide area network; a receiving agency server [See, for example: Fig. 1, ref. 20; page 6, lines 3-11; page 6, line 26 to page 7, line 2; page 7, line 13 to page 8, line 23] separate from said web server and coupled to said wide area network [See, for example: Fig. 1, ref. 12; page 6, lines 3-11] such that it is capable of communicating with said web server, said receiving agency server associated with a governmental agency responsible for the administration of trademark registration [See, for example: Fig. 2, page 9, line 34 to page 10, line 5]; a client machine [See, for example: Fig. 1, ref. 16; page 6, lines 3-11; page 6, line 26 to page 8, line 23] separate from said web server and said receiving agency server and coupled to said wide area network for communication with said web server, such that said web server serves as an interface [See, for example: Fig. 1, ref. 14; page 7, line 20] to said receiving agency server, said client machine providing information [See, for example: Fig. 1, ref. 22; page 7, line 20-31] to said web server forming at least a part of an electronic document related to prosecution of a trademark application or maintenance of a trademark registration, said electronic document to be filed with said receiving agency server by said web server in a manner that said web server serves as an interface to said receiving agency computer, said electronic document filed for further processing by said governmental agency in accordance with pre-established rules; wherein said web server automatically produces at least a portion of said electronic document in response to a selection [See, for example: page 8, line 11-15] originating from said client machine; and wherein said web server makes a payment [See, for example: Fig. 2, ref. 30d; page 8, line 24 to page 9, line 33] to said government agency for the filing of said electronic document.

In the embodiment of claim 32, set forth by way of example and not limitation, an automated electronic filing system [See, for example: Fig. 1, ref. 10; page 6, lines 6-11; page 7 lines 3-12] includes a web server [See, for example: Fig. 1, ref. 14; page 6, lines 3-11; page 6, line 26 to page 7, line 2; page 7, line 13 to page 8, line 23] capable of communicating over the Internet [See, for example: Fig. 1, ref. 12; page 6, lines 3-11]; a receiving agency server separate [See, for example: Fig. 1, ref. 20; page 6, lines 3-11; page 6, line 26 to page 7, line 2; page 7, line 13 to page 8, line 23] from said web server and capable of communicating over the Internet, said receiving agency server associated with a governmental agency; a client machine [See, for example: Fig. 1, ref. 16; page 6, lines 3-11; page 6, line 26 to page 8, line 23] separate from said web server and said receiving agency server and capable of communicating over the Internet,

such that said web server serves as an interface [*See*, for example: Fig. 1, ref. 14; page 7, line 20] to said receiving agency server, said client machine providing information [*See*, for example: Fig. 1, ref. 22; page 7, line 20-31] to said web server forming at least a part of an electronic document, said electronic document to be filed with said receiving agency server by said web server for further processing by said governmental agency in accordance with pre-established rules; and wherein said web server makes a payment [*See*, for example: Fig. 2, ref. 30d; page 8, line 24 to page 9, line 33] to said governmental agency on behalf of a client for the filing of said electronic document.

In the embodiment of claim 36, set forth by way of example and not limitation, a communications system includes a client computer [*See*, for example: Fig. 1, ref. 16; page 6, lines 3-11; page 6, line 26 to page 8, line 23]; one or more applicant computers [*See*, for example: Fig. 1, ref. 18; page 6, lines 3-11; page 6, line 26 to page 8, line 23] associated with said client computer; an intermediary server [*See*, for example: Fig. 1, ref. 14; page 6, lines 3-11; page 6, line 26 to page 7, line 2; page 7, line 13 to page 8, line 23] communicating with at least one of said client computer and said one or more applicant computers; and a recipient server communicating with said intermediary server over the Internet [*See*, for example: Fig. 1, ref. 12; page 6, lines 3-11].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The rejection of claims 1, 5-6, 12-15, 31, and 36 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,493,722 of Daleen et al. ("Daleen") and further in view of U.S. Patent No. 6,023,684 of Pearson ("Pearson") and further in view of U.S. Patent No. 5,732,219 of Blumer et al. ("Blumer").
- B. The rejection of claims 10-11 and 18-19 under 35 U.S.C. 103(a) as being unpatentable over Daleen, Pearson and Blumer and further in view of U.S. Patent No. 5,857,191 of Blackwell, Jr. et al. ("Blackwell").
- C. The rejection of claim 20 under 35 U.S.C. 103(a) as being unpatentable over Daleen, Pearson and Blumer and further in view of U.S. Patent No. 5,347,477 of Lee ("Lee").
- D. The rejection of claims 21 and 27 under 35 U.S.C. 103(a) as being unpatentable over U.S. Published Patent Application No. 2001/0011250 of Paltenghe et al. ("Paltenghe") and further in view of Daleen and further in view of U.S. Patent No. 6,345,278 of Hitchcock et al. ("Hitchcock").
- E. The rejection of claims 22 and 28 under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen and Hitchcock and further in view of U.S. Patent No. 5,740,361 of Brown ("Brown").
- F. The rejection of claims 23, 25-26, and 29 under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen, Hitchcock and Brown and further in view of U.S. Patent No. 5,604,802 of Holloway ("Holloway").
- G. The rejection of claims 24 and 30 under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen, Hitchcock, Brown and Holloway and further in view of U.S. Patent No. 6,122,622 of Wiitala et al. ("Wiitala").
- H. The rejection of claim 32 under 35 U.S.C. 103(a) as being unpatentable over Daleen and Pearson.

VII. ARGUMENTS

- A. The rejection of claims 1, 5-6, 12-15, 31, and 36 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,493,722 of Daleen et al. (“Daleen”) and further in view of U.S. Patent No. 6,023,684 of Pearson (“Pearson”) and further in view of U.S. Patent No. 5,732,219 of Blumer et al. (“Blumer”) was in error and should be reversed.

Independent claim 1 includes a web server, a client machine, and a receiving agency server each of which are separate from each other and each of which is coupled to a wide area network for communications purposes. The web server serves as an interface between the client machine and the receiving agency server to pass an electronic document to the receiving agency server for subsequent processing by the receiving agency server. Still further, the web server automatically provides a portion of the electronic document in response to a selection originating from the client machine.

By way of example, but not limitation, Daleen does not show a receiving agency server as asserted by the Examiner. The Examiner admits that a database, such as database 104 of Daleen, does not meet the receiving agency server limitation and instead relies on the Referring Page Web Server 106 as being the receiving agency server. However, the Referring Page Web Server does not meet the limitations for a receiving agency server as set forth in claim 1 including, by way of example and not limitation, receiving at least a part of an electronic document to be filed and further processed in accordance with a procedure for which the receiving agency is in some manner responsible. Furthermore, the Examiner admits that Daleen does not disclose an intermediate server that serves as an interface to a receiving agency server.

Pearson does not cure the deficiencies of Daleen as set forth above. Furthermore, contrary to the assertion of the Examiner, Pearson does not meet the limitations of a web server coupled to a wide area network and a receiving agency server separate from said web server and coupled to said wide area network such that it is capable of communication with said web server. In fact, even if, *arguendo*, the application server 56 is considered to be a receiving agency server, it is coupled directly to the web server 50, not to the wide area network. Even if the web server 50, *arguendo*, were considered to be an “intermediate server”, it does not communicate with the application server 56 through the wide area network (Internet 34 in Pearson).

The Examiner admits that Daleen fails to disclose “wherein the portion of the electronic document is automatically produced in response to a selection originating from a client.” The Examiner offers Blumer to meet this deficiency, and points to column 6, lines 4-34, reproduced below:

6

either the PUT method or the POST method, as these are the only two methods that allow such data transfer to the Web server.

Having now described the World Wide Web, a typical on-line service on the WWW will now be described. An on-line service on the World Wide Web includes a Web server program running on a Web server machine, and a set of service files that characterize the on-line services that are stored on the Web server machine. The service files include HTML documents, executable scripts or programs to dynamically produce HTML documents, and other files of service information that can be referenced and updated by the scripts and programs. The actual data and scripts that make up a particular on-line service, including HTML documents and script programs, are generally stored on the server in a separate area for each service. Global information about the service is also stored, including data such as the name of the service, the name of the author, revision history, comments about the service, and authorization information. The end user of the on-line service uses a Web browser program on the client machine to send requests to the on-line service and to receive responses from the on-line service. All access by an end user of the on-line service to the service files is managed and controlled by the Web server program. For example, an on-line service might consist of a corporate home page which is a static document, with a link to a second document that is a form for searching the store catalog. The search form may have a “submit” button that causes a script to be run on the Web server, to generate a list of product descriptions with prices that is then returned to the Web browser as an HTML document. Each of the HTML documents may have a link to a second script that collects and displays the items that have been ordered. The service also has configuration information such as the list of authorized users of the service, and their passwords.

A reading of this passage from Blumer indicates that Blumer is simply teaching a web server supporting dynamically reconfigurable web pages. Blumer says nothing about a web server which automatically produces at least a portion of an electronic document to be filed with a receiving agency in response to a selection from a client machine. Therefore, Blumer fails to cure the deficiencies of Daleen and Pearson with respect to this limitation as well.

In view of the forgoing, Appellants submit that the Examiner has not even made a *prima facie* case of obviousness in rejecting claim 1 over Daleen, Pearson and Blumer in that he has not demonstrated that all of the limitations of claim 1 can be found in these references. Appellants

respectfully request that the rejection of independent claim 1 and claims 5-6, 12-15 dependent thereupon be reversed.

Furthermore, with respect to claim 12, there is no description or suggestion in Daleen of an intermediate web server conducting a financial transaction with a receiving agency server on behalf of a client machine. As noted above, Daleen does not disclose a receiving agency server, let alone an intermediate web server conducting a financial transaction with a receiving agency server on behalf of a client machine. The rejection of claim 12 should be withdrawn for this reason as well.

Appellants also respectfully traverse the Examiner's rejection of claim 13 over Daleen. The Examiner asserts that the limitation of an "electronic document automatically provided in response to a selection originating from said client machine includes one of a blank form and a partially-filled-in form based upon information stored on said web server" can be found in Fig. 5A, item 508, reproduced below:

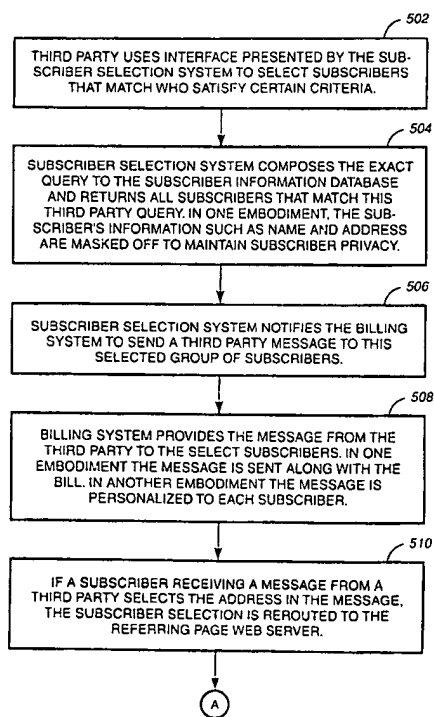


FIG. 5A

Appellants fail to see how this citation even remotely shows the limitation of claim 13.

Appellants also respectfully traverse the rejection of claims 14 and 15 which add the limitation of an applicant machine. In his rejection, he indicates that “network machines” are connected via a WAN in Daleen meet this limitation. This, however, does not meet the limitation of an applicant machine as defined by Appellants. *See*, for example:

As used here, the "client" will be referred to as the entity who initiates the transaction with the secure web site, as opposed to the "applicant" for whom the electronic document is being filed. Of course, the applicant may be the client, or the applicant may be working directly or indirectly with the client. Appellants' Summary, Page 3, lines 5-9

In the claimed embodiments, there is an applicant machine in addition to the client machine. As noted on page 6, line 5 of Appellants' specification, the applicant computer is optional. Therefore, in the claimed embodiments of claims 14 and 15, the applicant is in addition to the client machine, and not coincident with the client machine. There is no such combination disclosed in the art cited by the Examiner. Appellants respectfully request that the rejection of claims 14 and 15 be withdrawn for this reason as well.

Independent claim 31 is a system claim similar to the system claim 1 and is patentable over the cited art for at least the same reasons as set forth above with respect to claim 1, which will not be repeated here for conciseness and brevity. In addition, there is the limitation of wherein said web server makes a payment to said government agency for the filing of said electronic document. The Examiner rejects this claim by taking “Official Notice” that “filing of (sic) trademark application and payment for such an application was notoriously well known in the art at the time of the invention.” Appellants respectfully traverse. The claim limitation is that the web server, which is the intermediary between the agency server and the client/applicant machines makes the payment for the client/applicant. Not only is this not “notoriously well known,” to the knowledge of Appellants this has not yet being done. The rejection of claim 31 is clearly in error and should be reversed.

The Examiner indicated that claim 36 was “similarly rejected” as per claim 31. This hard to understand, as the claims are considerably different. They are reproduced side-by-side below for comparison purposes.

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| | |
|--|--|
| <p>31. An automated electronic filing system for use in electronic prosecution of trademark applications comprising:</p> <p>a web server coupled to a wide area network;</p> <p>a receiving agency server separate from said web server and coupled to said wide area network such that it is capable of communicating with said web server, said receiving agency server associated with a governmental agency responsible for the administration of trademark registration;</p> <p>a client machine separate from said web server and said receiving agency server and coupled to said wide area network for communication with said web server, such that said web server serves as an interface to said receiving agency server, said client machine providing information to said web server forming at least a part of an electronic document related to prosecution of a trademark application or maintenance of a trademark registration, said electronic document to be filed with said receiving agency server by said web server in a manner that said web server serves as an interface to said receiving agency computer, said electronic document filed for further processing by said governmental agency in accordance with preestablished rules;</p> <p>wherein said web server automatically produces at least a portion of said electronic document in response to a selection originating from said client machine; and</p> <p>wherein said web server makes a payment to said government agency for the filing of said electronic document.</p> | <p>36. A communications system comprising:</p> <p>a client computer;</p> <p>one or more applicant computers associated with said client computer;</p> <p>an intermediary server communicating with at least one of said client computer and said one or more applicant computers; and</p> <p>a recipient server communicating with said intermediary server over the Internet.</p> |
|--|--|

Claim 31 is directed to an automated electronic filing system for the electronic prosecution of trademark applications. Claim 36 is directed to a communications system. While both claims 31 and 36 include a client “machine” or “computer”, only claim 36 has the limitation of one or more applicant computers. Furthermore, claim 36 does not include the limitations associated with the automated prosecution of trademark applications nor any provisions for

electronic payment to the government agency. Therefore, the Examiner has not made a *prima facie* case of obviousness with respect to claim 36, and his rejection should be reversed.

- B. The rejection of claims 10-11 and 16-19 under 35 U.S.C. 103(a) as being unpatentable over Daleen, Pearson and Blumer and further in view of U.S. Patent No. 5,857,191 of Blackwell, Jr. et al. ("Blackwell") was in error and should be reversed.

It should be noted that claims 10-11 and 16-19 are directly or indirectly dependent upon claim 1 and, therefore, are patentable for at least the reasons set forth above. In addition, since the cited art does not teach the combination of a client machine, a web server, and a receiving agency server, the Examiner has failed to show the limitation of "wherein communications between said communications between said client machine and said web server are at least partially encrypted" of claim 10 and "wherein communications between said client machine and said web server are subject to authentication" of claim 11. With respect to claims 16-19, the Examiner makes the same error with respect to an even more complex system architecture claimed by Appellants which include applicant machines. While the Examiner offers Blackwell as showing encryption and authentication are known in client/server applications, the Examiner fails to show the claimed encryption and authentication methodologies as recited in Appellants' claimed system architectures. The rejection of claims 10-11 and 16-19 are clearly in error and should be reversed.

- C. The rejection of claim 20 under 35 U.S.C. 103(a) as being unpatentable over Daleen, Pearson and Blumer and further in view of U.S. Patent No. 5,347,477 of Lee ("Lee") was in error and should be reversed.

It should be noted that claim 20 is indirectly dependent upon claim 1 and, therefore, is patentable for at least the reasons set forth above. In addition, claim 20 includes the limitation that "said web server provides said client machine with a form that can be at least partially automatically filled-in in response to said selection." The reference, Lee, was offered to meet this limitation. Lee, however, discloses a pen computer, not a web server that provides a client machine with a form that can be at least partially automatically filled-in in response to a selection. The Examiner points to the Abstract of Lee, reproduced below:

A pen-based form computer using "Form" as the operation metaphor between users and the computer, which allows an user to directly operate the information stored in the computer or any remote systems without learning commands, file

names, file types, and other details regarding computer internal structure. It is applicable for use in medical prescription control, order registration control, inventory inquiry control, data collection. It can also be used as a front-end system in a client and server structure. The pen-based form computer comprises a pen for data entry, and a complete Multi-tasking Preemptive Pen Based Form Operation software system for form operation metaphor, graphical form making procedure, multiple form data association, multiple form operation language, remote form data accessing, automatic database association, and hand-writing recognition. External keyboard for data entry is acceptable. The preferred embodiment of the invention is within 2 lbs and about the size of a B5 paper. It uses a pressure-sensitive touch panel overlaid LCD for data entry with the pen, and an infrared, RS-232, off-the-shelf modem, and radio transceiver as communication mediums. Lee, Abstract.

As noted in the Abstract, the pen can be used as a “front-end system in a client and server structure.” Therefore, the pen is the client (the server being the “back-end system”). There is no disclosure in Lee that the server provides a form to the pen that can be at least partially automatically filled in response to a selection by the pen. In fact, the only mention of server is in Lee’s Abstract. Furthermore, the web server of Appellants’ claim 20 is an intermediary server to a receiving agency server, which is not shown in the cited combination. The rejection of claim 20 is therefore also in error and should be reversed.

- D. The rejection of claims 21 and 27 under 35 U.S.C. 103(a) as being unpatentable over U.S. Published Patent Application No. 2001/0011250 of Paltenghe et al. (“Paltenghe”) and further in view of Daleen and further in view of U.S. Patent No. 6,345,278 of Hitchcock et al. (“Hitchcock”) was error and should be reversed.

Independent claim 21 claims an example embodiment where an intermediary web server provides assistance in filling out an HTML form for a client prior to submitting it to a receiving agency over the Internet. Claim 27 has similar limitations and can stand or fall with claim 21.

The Examiner has, again, failed to make a *prima facie* case of obviousness with respect to the rejection of claims 21 and 27. Paltenghe describes a system where a “Consumer” can communicate with a “Doctor’s Office”, and both can communicate with an “Information Bank.” With reference to Fig. 2 of Paltenghe, a Courtesy Account 31 is stored in the Information Bank 23 so that a patient can see certain medical records. A description can be found in paragraph 19 of Paltenghe:

[0019] The system of the information bank can thus provide, in specific aspects, three types of accounts: a courtesy account, a service account, and a value generation account. Basic information can be stored in the information bank courtesy account and used for automated "form filling" services which are useful to

the consumer as an easy means for providing personal information to others when and as authorized. This service may also include a digital signing service, a digital signature verification service, and, for example, notary services.

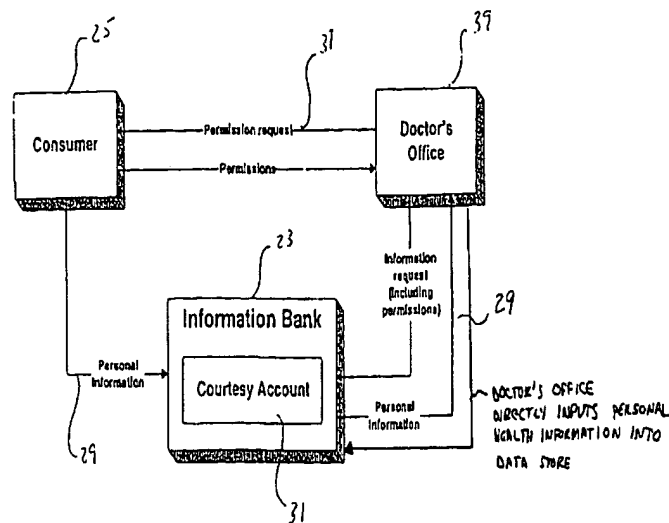


FIG. 2

Therefore, to follow the Examiner's logic, the Information Bank 31 is the "web server coupled to the Internet." If this is the case, the Information Bank 31 must create an HTML form for a client, partially fill it in, and verify it before submitting the filled-in form to a receiving agency over the Internet. However, there is no receiving agency shown, suggested or described by Paltenghe. Daleen does not cure this problem, since Daleen also does not teach a receiving agency server. Furthermore, Paltenghe in no way describes or implies that HTML forms are used in his system, contrary to the assertion of the Examiner. Hitchcock does not cure the deficiencies of claim 21 or 27 with respect to Paltenghe and Daleen. Appellants respectfully request that the rejection of claims 21 and 27 be reversed.

- E. The rejection of claims 22 and 28 under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen and Hitchcock and further in view of U.S. Patent No. 5,740,361 of Brown ("Brown") was in error and should be reversed.

Claim 22 is dependent upon claim 21 and claim 28 is dependent upon claim 27. Therefore, claims 22 and 28 are patentable for at least the same reasons as set forth above with respect to claims 21 and 27.

Furthermore, with respect to claims 22 and 28, the cited art fails to disclose the limitation of "adding additional information to said form based upon input from said client machine prior

to verifying said information.” Brown is said to “verify the information” on the form based upon stored heuristics. The Examiner points to column 3, lines 62-63 (reproduced below) with his assertion that “verifying the information” limitation is met by providing a user name and password:

One technique to address this problem is to have the service prompt the user for her pass-phase. For example, a 60 WWW service may display a Hyper-Text Markup Language (HTML) form with two boxes—one that asks for the user for her user name and one that asks her for her pass-phrase. A

It is clear that the account number and password of Brown only indicates that the user is *authorized* to access the system. It does not provide a *verification of the information on a form*. The Examiner is clearly in error and the rejection of claims 22 and 28 should be reversed.

- F. The rejection of claims 23, 25-26, and 29 under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen, Hitchcock and Brown and further in view of U.S. Patent No. 5,604,802 of Holloway (“Holloway”) was in error and should be reversed.

It should be noted that claims 23, 25 and 26 are directly or indirectly dependent upon claim 22 and are therefore patentable for at least the same reasons as set forth above. Claim 29 is dependent on claim 28 and is therefore patentable for at least the same reasons as set forth above. Holloway is presented to disclose the existence of electronic signatures, but does not disclose obtaining an electronic signature prior to submitting a form to a receiving agency as claimed by Appellants. The rejection of claims 23, 25-26 and 29 is therefore also clearly in error and should be reversed.

- G. The rejection of claims 24 and 30 under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen, Hitchcock, Brown and Holloway and further in view of U.S. Patent No. 6,122,622 of Wiitala et al. (“Wiitala”) was in error and should be reversed.

Claim 24 is dependent upon claim 23 and claim 30 is dependent on claim 29. Claims 24 and 30 are, therefore, patentable for at least the same reasons as set forth above with respect to claims 23 and 29.

Furthermore, the Examiner errs in asserting that Wiitala discloses the payment of a filing fee as claimed by Appellants. The Examiner erroneously points to the Abstract of Wiitala as disclosing a filing fee, which is reproduced below:

[57]

ABSTRACT

An automated system of integrated computer programs and files facilitates compliance with Chemical Control Laws of different jurisdictions. In one embodiment, the system uses a raw material database file, a formula database file, a manufacturing status database file, a sales status database file, a regulatory worksheet program, and an update program, all residing on a computer system. These files and programs are collectively used to: maintain Chemical Control Law inventories; maintain records of chemical and product Chemical Control Law registrations; provide a basis for automated control of chemical or product manufacturing, distribution, importing and exporting through the generation of country or regional manufacturing and sales status; generate certification letters; generate Chemical Control Law manufacturing and sales statuses for particular countries or regions of the world; and provide real-time updating of a chemical's or product's manufacturing and sales status.

Appellants fail to see where the Abstract of Wiitala discloses a filing fee at all, let alone one for paying a filing fee to a receiving agency in conjunction with the submission of a form to the receiving agency. The only time Wiitala discusses a fee is in his Background of the Invention section where he is apparently talking about the filing of paper forms with appropriate fees (presumably checks). The rejections of claims 24 and 30 are clearly in error and should be reversed.

- H. The rejection of claim 32 under 35 U.S.C. 103(a) as being unpatentable over Daleen and Pearson was in error and should be reversed.

Independent claim 32 includes a web server, a client machine, and a receiving agency server each of which are separate from each other. The web server, client machine and receiving agency server communicate amongst each via the Internet. The web server serves as an interface between the client machine and the receiving agency server to pass an electronic document to the receiving agency server for subsequent processing by the government agency associated with the

receiving agency server. Still further, the web server makes a payment to the government agency on behalf of the client for the filing of the electronic document.

As noted with respect to claim 1, Daleen does not show a receiving agency server as asserted by the Examiner. The Examiner admits that a database, such as database 104 of Daleen, does not meet the receiving agency server limitation and instead relies on the Referring Page Web Server 106 as being the receiving agency server. However, the Referring Page Web Server does not meet the limitations for a receiving agency server as set forth in claim 1 including, by way of example and not limitation, receiving at least a part of an electronic document to be filed and further processed in accordance with a procedure for which the receiving agency is in some manner responsible. Furthermore, the Examiner admits that Daleen does not disclose an intermediate server that serves as an interface to a receiving agency server.

Pearson does not cure the deficiencies of Daleen as set forth above. Furthermore, contrary to the assertion of the Examiner, Pearson does not meet the limitations of a web server coupled to a wide area network and a receiving agency server separate from said web server and coupled to said wide area network such that it is capable of communication with said web server. As noted above with reference to claim 1, even if, *arguendo*, the application server 56 is considered to be a receiving agency server, it is coupled directly to the web server 50, not to the wide area network. Even if the web server 50, *arguendo*, were considered to be an “intermediate server”, it does not communicate with the application server 56 through the wide area network (Internet 34 in Pearson).

It should also be noted that the Examiner failed to address the limitation that the web server makes a payment to the government agency on behalf of the client. In his rejection of claims 24 and 30 he erroneously attempted to use Wiitala to add this limitation to the disclosure of Daleen and other cited art. This would imply that this limitation can be found in Pearson, since the Examiner admits that it is not found in Daleen. However, a review of Pearson shows no mention of using a web server to make a payment to a governmental agency on behalf of a client for the filing of an electronic document.

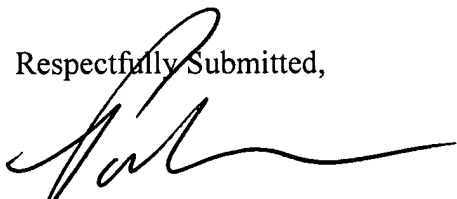
Furthermore, Appellants’ do not understand the Examiner’s rejection of claim 32. He indicates that Daleen fails to specifically disclose that the filing is a trademark application. However, Appellants are not claiming the filing of trademark applications in the embodiment of

claim 32. Nonetheless, Appellants again traverse the Examiner's "official notice" that the filing of trademark applications and the payment of filing for such applications as claimed by Appellants were "notoriously well known in the art at the time" of Appellants' invention(s).

In view of the forgoing, Appellants submit that the Examiner has not even made a *prima facie* case of obviousness in rejecting claim 32 over Daleen and Pearson. Appellants respectfully request that the rejection of claim 32 be reversed.

VIII. CONCLUSION

The rejections of claims 1, 5, 6, 10-32 and 36 were clearly in error for at least the reasons set forth above. Appellants respectfully request that the rejection of the claims be reversed.

Respectfully Submitted,

Paul L. Hickman
Reg. No. 28,516

IX. CLAIMS APPENDIX

1. An automated electronic filing system comprising:
 - a web server coupled to a wide area network;
 - a receiving agency server separate from said web server and coupled to said wide area network such that it is capable of communication with said web server;
 - a client machine separate from said web server and said receiving agency server and coupled to said wide area network for communication with said web server, such that said web server serves as an interface to said receiving agency server, said client machine providing information to said web server forming at least a part of an electronic document to be filed with said receiving agency server by said web server in a manner that said web server serves as an interface to said receiving agency computer, said electronic document filed for further processing by a receiving agency associated with said receiving agency server in accordance with a procedure for which said receiving agency is in some manner responsible; and
 - wherein said web server automatically produces at least a portion of said electronic document in response to a selection originating from said client machine.
5. An automated electronic filing system as recited in claim 1 wherein said network includes a TCP/IP protocol network.
6. An automated electronic filing system as recited in claim 5 wherein said TCP/IP protocol network includes the Internet.
10. An automated electronic filing system as recited in claim 1 wherein communications between said client machine and said web server are at least partially encrypted.

11. An automated electronic filing system as recited in claim 1 wherein communications between said client machine and said web server are subject to authentication.
12. An automated electronic filing system as recited in claim 1 wherein said web server transacts a financial transaction with said receiving agency server on behalf of said client machine.
13. An automated electronic filing system as recited in claim 1 wherein said portion of said electronic document automatically provided in response to a selection originating from said client machine includes one of a blank form and a partially filled-in form based upon information stored on said web server.
14. An automated electronic filing system as recited in claim 1 further comprising an applicant machine coupled to said wide area network.
15. An automated electronic filing system as recited in claim 14 wherein said applicant machine communicates with said web server over said wide area network.
16. An automated electronic filing system as recited in claim 15 wherein communications between said applicant machine and said web server are at least partially encrypted.
17. An automated electronic filing system as recited in claim 15 wherein communications between said applicant machine and said web server are subject to authentication.

18. An automated electronic filing system as recited in claim 1 wherein communications between said receiving agency server and said web server are at least partially encrypted.

19. An automated electronic filing system as recited in claim 15 wherein communications between said receiving agency server and said web server are subject to authentication.

20. An automated electronic filing system as recited in claim 13 wherein said web server provides said client machine with a form that can be at least partially automatically filled-in in response to said selection.

21. A method for electronically filing documents over the Internet via an intermediary web server comprising:

prior to the following acts, storing data useful for populating an HTML based form on a web server coupled to the Internet;

providing access to said HTML based form by a client machine which is separate from said web server and which is coupled to the Internet;

at least partially automatically filling in said form on said web server with suitable data selected from said data useful for populating said HTML based form based upon input from said client machine;

verifying on said web server completeness of said form and information of said form based upon stored heuristics; and

submitting by said web server said form to a receiving agency over the Internet.

22. A method for electronically filing documents as recited in claim 21 further comprising:

adding additional information to said form based upon input from said client machine prior to verifying said information.

23. A method for electronically filing documents as recited in claim 22 further comprising obtaining an electronic signature prior to submitting said form to said receiving agency.

24. A method for electronically filing documents as recited in claim 23 further comprising paying a filing fee to said receiving agency in conjunction with the submission of said form to said agency.

25. A method for electronically filing documents as recited in claim 23 wherein said electronic signature is obtained from said client machine.

26. A method for electronically filing documents as recited in claim 23 wherein said electronic signature is obtained from said client machine coupled to said TCP/IP network.

27. A computer readable media including code segments for electronically filing documents over the Internet via an intermediary web server comprising:

a code segment for storing data useful for populating an HTML based form on a web server coupled to the Internet;

a code segment providing access to said HTML based form by a client machine which is separate from said web server and which is coupled to the Internet;

a code segment at least partially automatically filling in said form on said web server with suitable data selected from said data useful for populating said HTML based form based upon input from said client machine;

a code segment verifying on said web server completeness of said form and information of said form based upon stored heuristics; and

a code segment submitting by said web server said form to a receiving agency over the Internet.

28. A computer readable media as recited in claim 27 further comprising:

a code segment adding additional information to said form based upon input from said client machine prior to verifying said information.

29. A computer readable media as recited in claim 28 further comprising a code segment obtaining an electronic signature prior to submitting said form to said receiving agency.

30. A computer readable media as recited in claim 29 further comprising a code segment paying a filing fee to said receiving agency in conjunction with the submission of said form to said agency.

31. An automated electronic filing system for use in electronic prosecution of trademark applications comprising:

a web server coupled to a wide area network;

a receiving agency server separate from said web server and coupled to said wide area network such that it is capable of communicating with said web server, said receiving agency server associated with a governmental agency responsible for the administration of trademark registration;

a client machine separate from said web server and said receiving agency server and coupled to said wide area network for communication with said web server, such that said web server serves as an interface to said receiving agency server, said client machine providing information to said web server forming at least a part of an electronic document related to prosecution of a trademark application or maintenance of a trademark registration, said electronic document to be filed with said receiving agency server by said web server in a manner that said web server serves as an interface to said receiving agency computer, said electronic document filed for further processing by said governmental agency in accordance with preestablished rules;

wherein said web server automatically produces at least a portion of said electronic document in response to a selection originating from said client machine; and

wherein said web server makes a payment to said government agency for the filing of said electronic document.

32. An automated electronic filing system comprising:

a web server capable of communicating over the Internet;

a receiving agency server separate from said web server and capable of communicating over the Internet, said receiving agency server associated with a governmental agency;

a client machine separate from said web server and said receiving agency server and capable of communicating over the Internet, such that said web server serves as an interface to said receiving agency server, said client machine providing information to said web server forming at least a part of an electronic document, said electronic document to be filed with said receiving agency server by said web server for further processing by said governmental agency in accordance with pre-established rules; and

wherein said web server makes a payment to said governmental agency on behalf of a client for the filing of said electronic document.

36. A communications system comprising:

a client computer;

one or more applicant computers associated with said client computer;

an intermediary server communicating with at least one of said client computer and said one or more applicant computers; and

a recipient server communicating with said intermediary server over the Internet.

XII. EVIDENCE APPENDIX

X. RELATED PROCEEDINGS APPENDIX

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

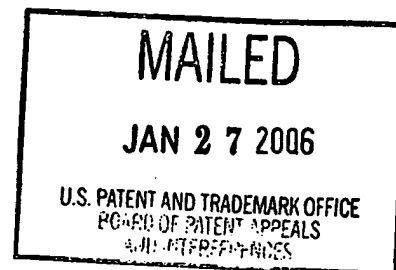
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN AND JAMES J. GOUGH

Appeal No. 2005-2460
Application No. 09/648,715

ON BRIEF



Before RUGGIERO, BARRY, and NAPPI, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 3-5, 7, 9, 11-14, and 16-18, which are all of the claims pending in the present application.

The claimed invention relates to a system and method for electronic mail notification in which a determination is made that it is time for at least one of a reminder notification action and a report notification action. For a reminder notification action, all action items which fall within a given range are obtained and processed into a reminder action item report and e-mailed to at least one designated recipient. For a report notification action, a list of completed action items in a given range is obtained and processed into a completed action report and e-mailed to at least one designated recipient.

Claim 1 is illustrative of the invention and reads as follows:

A method for electronic mail notification comprising:

determining that it is a time for at least one of a reminder notification action and a report notification action;

opening a docketing program;

running a report;

saving the report for further processing;

for a reminder notification action, obtaining all action items within a given range from said report and processing the action items into at least one action item report and e-mailing the at least one action item report to at least one designated recipient; and

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for a report notification action, obtaining a list of completed action items in a given range from said report and processing the list of completed action items into at least one completed action report and e-mailing the at least one completed action report to at least one designated recipient.

The Examiner relies on the following prior art:

| | | |
|---|-----------|--|
| Milewski et al. (Milewski) | 5,930,471 | Jul. 27, 1999 (filed Dec. 26, 1996) |
| Ariyama et al. (Ariyama) (Published Japanese Patent Application) | 11-143936 | May 28, 1999 |

Claims 1, 3-5, 7, 9, 11-14, and 16-18, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Milewski in view of Ariyama.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

Initially, we note that Appellants have provided arguments as to the sufficiency of the drawings. However, the issue of the sufficiency of the drawings relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining

¹ The Appeal Brief (revised) was filed August 10, 2004. In response to the Examiner's Answer mailed October 19, 2004, a Reply Brief was filed December 23, 2004, which was acknowledged and entered by the Examiner as indicated in the communication mailed March 16, 2005.

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Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by Appellants on pages 5 and 6 of the Brief and pages 1-3 of the Reply Brief.

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 1, 3-5, 7, 9, 11-14, and 16-18. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one

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having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 5, 7, 9, 12-14, 17, and 18 based on the combination of Milewski and Ariyama, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since proper motivation for the Examiner's proposed combination has not been set forth. In addition, Appellants assert that, even if combined, all of the claimed limitations would not be taught or suggested by the applied

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Milewski and Ariyama references. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

In our view, to whatever extent the missing reminder time determination feature of Milewski may be present in Ariyama, we find no indication from the Examiner as to how and in what manner the Milewski reference would be combined with Ariyama to arrive at the claimed invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.

We are further of the view that, even assuming arguendo that proper motivation were established for the combination of Milewski and Ariyama, the resultant combination would not satisfy the particular limitations of the appealed claims. As asserted by Appellants (Brief, page 7; Reply Brief, page 3), we find no disclosure in Milewski, or in Ariyama, which would satisfy the

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"opening a docketing program" feature which appears in each of the appealed independent claims. We agree with Appellants that the portion of Milewski relied upon by the Examiner, i.e., column 8, lines 30-37 which is directed to the accessing of a structured response template by a sender, has no relationship to a "docketing program" as claimed.

We recognize that the Examiner, at page 8 of the Answer, has expanded the line of reasoning which asserts that Milewski provides a disclosure of the claimed "docketing program." According to the Examiner, the accessing of controller 12 by sender station 14 in Milewski using conventional stored program instructions would satisfy the claimed "opening a docketing program" limitation. We can find no basis on the record before us for the Examiner interpreting the claim language in this manner. In our view, the Examiner's interpretation could only be reached by pointedly ignoring the precise language of the claims on appeal, i.e., effectively and improperly reading out the language "docketing program" from the claims. Our reviewing courts have held that, in assessing patentability of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the

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MENLO PARK, CA 94025-1114

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

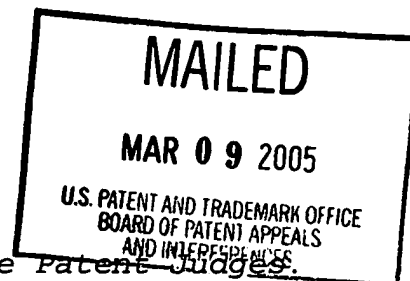
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN and JAMES J. GOUGH

Appeal No. 2004-1838
Application No. 09/488,862

ON BRIEF



Before HAIRSTON, KRASS, and OWENS, Administrative Patent Judges.
OWENS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-15 and 17-21, which are all of the pending claims.

THE INVENTION

The appellants claim a computer implemented method, an electronic document filing system and a computer program for electronically filing documents with a receiving agency. Claim 1, which claims the computer implemented method, is illustrative:

OPINION

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 1, 8 and 15.¹

Claim 1 requires encrypting processed electronic document data before providing it from a client computer to a receiving agency computer over a network, whereby the receiving agency computer decrypts the processed electronic document data.

Claim 8 requires encrypting processed electronic data before it is transmitted from a client computer, receiving the encrypted, processed electronic document data at a receiving agency computer via a computer network, and decrypting the processed electronic document data. Claim 15 requires a code segment on a client computer that encrypts processed electronic document data, and a code segment on the client computer that provides the encrypted, processed electronic document data to a receiving agency computer.

Hitchcock discloses (col. 2, lines 1-12):

The present invention comprises a universal forms engine that permits the creation and processing of customizable electronic forms and selective sharing of information between the customized forms. A user thus enters data only once, and the data is shared through

¹ The examiner does not rely upon Muramatsu for any disclosure that remedies the deficiency in Hitchcock as to the independent claims.

an extensible database between disparate forms. The forms are completed by a user over a computer network and information from each completed form is forwarded to the appropriate entity over a computer network. The ability of the forms engine to present a form for user input, to receive data from the user, and to provide the data to the appropriate entity is independent of the computing platform of the user and the entity.

The examiner incorrectly states that Hitchcock discloses encrypting and decrypting processed electronic document data (answer, page 3). The examiner then acknowledges that Hitch does not disclose encrypting and decrypting processed electronic document data, and argues that "transferring data between two computers connected by an open communication channel in a secure and encrypted manner is a well-established practice" (answer, pages 3-4). In support of that argument the examiner relies upon two references other than Hitchcock and Muramatsu (answer, page 6). Because the additional references are not included in the statement of the rejection, they are not properly before us. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Accordingly, we have not considered those references in reaching our decision.

The examiner's argument is not well taken even if encryption and decryption were well known in the art at the time of the appellants' invention. To establish a *prima facie* case of obviousness of the claimed invention the examiner must provide

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Application No. 09/488,862

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/488,862

01/21/2000

Paul L. Hickman

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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

06/19/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN and JAMES J. GOUCH

Appeal No. 2008-0830
Application No. 09/488,862
Technology Center 3600

Decided: June 19, 2008

Before WILLIAM F. PATE, III, TERRY J. OWENS and ANTON W. FETTING,
Administrative Patent Judges.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

The Appellants appeal from a rejection of claims 1-15 and 17-21, which are all of the pending claims.

THE INVENTION

The Appellants claim a method, electronic document filing system and computer program for filing documents with a receiving agency. Claim 1 is illustrative:

1. A computer implemented method for electronically filing documents with a receiving agency:

receiving unencrypted electronic document data comprising an HTML form at a client computer via a computer network, wherein the electronic document data is related to an electronic document to be securely filed with a receiving agency computer also connected to said computer network;

adding information to the electronic document data using a browser running on the client computer to develop processed electronic document data;

encrypting the processed electronic document data before providing it to the receiving agency computer over the network, whereby the receiving agency computer decrypts the processed electronic document data and eventually processes the electronic document data and files the electronic document corresponding to the processed electronic document data at the receiving agency; and

providing a response to the client computer, wherein the response includes information related to the electronic document as filed with the receiving agency computer.

THE REFERENCES

Hitchcock US 6,345,278 B1 Feb. 5, 2002

Muramatsu et al., "The Construction of the Paperless System in Japan Patent Office" 278-87, IEEE 0-8186-2697 (June 1992).

Purcell et al., "Electronic Patent Application Filing System (EPAFS): A Demonstration Project of the U.S. Patent and Trademark Office", 38 *Jurimetrics J.* 407 (1998).

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-12, 14, 15 and 17-21 over Hitchcock in view of Purcell, and claim 13 over Hitchcock in view of Purcell and Muramatsu.

OPINION

We reverse the Examiner's rejections. We need to address only the independent claims, i.e., claims 1, 8 and 15.¹ Each of those claims requires receiving unencrypted electronic document data comprising an HTML form at a client computer via a computer network, adding information to the electronic document data using a browser running on the client computer to produce processed electronic document data, and encrypting the processed electronic document data before providing it to a receiving agency computer over the network.

Hitchcock discloses (col. 2, ll. 1-12):

The present invention comprises a universal forms engine that permits the creation and processing of customizable electronic forms and selective sharing of information between the customized forms. A user thus enters data only once, and the data is shared through an extensible database between disparate forms. The forms are completed by a user over a computer network and information from each completed form is forwarded to the appropriate entity over a computer network. The ability of the forms engine to present a form for user input, to receive data from the user, and to provide the data to the appropriate entity is independent of the computing platform of the user and the entity.

Purcell discloses a proposed U.S. Patent and Trademark Office electronic patent application filing system wherein:

Transmission level security will be provided by strong encryption systems integrated in domestic WWW browsers providing 128-bit SSL. The stored patent application information and the composite PDF file are strongly encrypted using triple-DES [p. 8, ¶ 2].

¹ The Examiner does not rely upon Muramatsu for any disclosure that remedies the deficiency in Hitchcock and Purcell as to the independent claims (Ans. 5).

The Examiner argues that “it would have been obvious to one having ordinary skill in the art at the time of the invention to have included the steps of using SSL protocol or any other secure and encrypted methods to communicate in a secure manner data between a client computer and a server for the motivation of privacy, confidentiality and prevention of unauthorized parties from eavesdropping” (Ans. 3-4).

The Examiner does not address, in either the explanation of the rejection (Ans. 3-4) or the response to arguments (Ans. 5-10), the Appellants’ independent claim requirements set forth above of receiving unencrypted electronic data at a client computer over a computer network, adding information to the electronic data at the client computer to produce processed electronic document data, and encrypting the processed electronic document data before sending it to another computer over the network. The Examiner refers us to Purcell to provide the encryption limitations. This alone is insufficient to complete a prima facie case because the Examiner does not make any findings as to the serial set of unencrypted followed by encrypted transactions as claimed, nor does the Examiner even provide a rationale for such a combination.

The Examiner, therefore, has not established a prima facie case of obviousness of the Appellants’ claimed invention.

DECISION

The rejections under 35 U.S.C. § 103 of claims 1-12, 14, 15 and 17-21 over Hitchcock in view of Purcell, and claim 13 over Hitchcock in view of Purcell and Muramatsu are reversed.

REVERSED

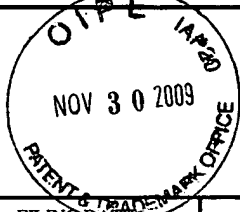
Appeal 2008-0830
Application 09/488,862

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN and JAMES J. GOUGH

Appeal 2007-3206
Application 09/488,863
Technology Center 2100

Decided: March 19, 2008

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and JEAN R.
HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-21. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

Many1 governmental agencies allow the electronic filing of legal documents. For example, some courts allow complaints and briefs to be filed electronically. For another example, the United States Patent and Trademark Office allows trademark applications to be filed electronically. (Spec. 1.)

According to the invention at issue on appeal, a client computer sends data to an electronic document filing server via a computer network. Generally, the data concern an electronic document to be filed with an agency's computer, which is separate from the client computer and the server. The electronic document filing server processes the data and provides the processed data to the agency's computer. When the latter computer files the data, the server provides a response, including information related to the filed data, to the client computer. (*Id.* 35.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A computer implemented method for electronically filing documents with a receiving agency utilizing a remote server, the computer implemented method comprising the operations of:

receiving electronic document data at an electronic document filing server from a remote client computer via a

computer network, wherein the electronic document data is related to an electronic document to be filed with a receiving agency computer separate from both the client computer and the electronic document filing server, said electronic document data being entered via a web browser application being executed on said client computer;

processing the electronic document data utilizing the electronic document filing server;

providing the processed electronic document data to the receiving agency computer via the electronic document filing server, wherein the receiving agency computer eventually files the processed electronic document data; and

providing a response to the client computer via the electronic document filing server, wherein the response includes information related to electronic document data as filed with the receiving agency computer.

C. REJECTION

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,185,683 ("Ginter") and U.S. Patent Application Pub. No. 2002/0059235 ("Jecha").

II. CLAIMS 1-4, 8-11, AND 15-18

1 "When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue

claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(vii) (2006).¹

Here, the Appellants argue claims 1-4, 8-11, and 15-18, which are subject to the same ground of rejection, as a group. (Sub. App. Br.² 5-12.) We select claim 1 as the sole claim on which to decide the appeal of the group. "With this representation in mind, rather than reiterate the positions of the parties *in toto*, we focus on the issues therebetween." *Ex Parte Zettel*, No. 2007-1361, 2007 WL 3114962, at *2 (BPAI 2007).

A. CLIENT COMPUTER

The Examiner finds, "Ginter teaches an inventor/applicant 5060 could use electronic appliance 600[A] (*i.e., the client computer*)" (Rev. Ans.³ 9.) The Appellants argue, "The appliance 600 is clearly requires [sic] specialized software to communicate with the trusted electronic go-between 4700" (Reply Br. 2) and "The point that the Examiner repeatedly

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Substitute Appeal Brief. The current version includes the same rules.

² We rely on and refer to the Substitute Appeal Brief, in lieu of the original Appeal Brief, because the latter was defective. We will not consider the original in deciding this appeal.

³ We rely on and refer to the Revised Examiner's Answer, in lieu of the original Examiner's Answer, because the latter was defective. We will not consider the original in deciding this appeal.

misses is that Appellant's claimed embodiments allow a standard computer (without special purpose software) to communicate" (*Id.* 3.)

Therefore, the issue is whether the Appellants have shown error in the Examiner's finding that the claimed client computer reads on the electronic appliance 600A shown in Fig. 132.

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Here, the features on which the Appellants rely for patentability, viz., allowing a standard computer to communicate without special purpose software, are absent from the representative claim. Therefore, the arguments based on these features cannot show error in the Examiner's finding that the claimed client computer reads on the electronic appliance 600A shown in Fig. 132.

B. AGENCY COMPUTER

The Examiner finds, "Ginter teaches the trusted electronic go-between 4700 which is a computer that performs its functions electronically in a highly automatic and efficient way . . . and the secure electronic

archive 4702 are separate computers/servers" (Rev. Ans. 9.) The Appellants "submit[] that the trusted electronic go-between 4700 and the secure electronic archive 4702 collectively comprise the agency computer." (Reply Br. 2.) Therefore, the issue is whether Ginter teaches an agency computer separate from a client computer and an electronic document filing server.

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently" *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995)). Furthermore, "[a]ll of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art." *In re Boe*, 355 F.2d 961, 965 (CCPA 1966)). "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968)).

Here, Ginter's "FIG. 132 shows how system 4050 might be used by Patent Office automation." (Col. 57, ll. 54-55). The system includes "a

trusted go-between 4700" (*id.* ll. 63-64) and "a secure electronic archive 4702" (col. 58, ll. 7-8). For its part, the reference's "FIG. 119 shows an example architecture for a trusted go-between 4700" (Col. 44, ll. 43-44.) More specifically, the latter Figure depicts the trusted go-between 4700 as "an electronic appliance 600" (*id.* ll. 45-46) that includes "a secure electronic archive 4072." (*Id.* ll. 47-48.) Based on these teaching, we agree with the Appellants that the trusted electronic go-between 4700 and the secure electronic archive 4702 collectively constitute the same computer. (Reply Br. 2.)

Ginter's system 4050, however, also includes an electronic appliance 600B, "such as [a] personal computer[] or computer workstation[]" (Col. 16, ll. 26-27.) Figure 132 shows that the electronic appliance 600B is separate from the system's trusted go-between 4700 and its client computer 600A. The reference's teaching that "[a] patent examiner 5064 could examine the patent application 5062 by requesting a copy of it from electronic archive 4702" (col. 58, ll. 13-15) also evidences that the patent examiner's appliance 600B is separate from the system's electronic archive 4702.

Because the appliance 600B receives and stores the requested copy for "review" (*id.* l. 20), we find that it "eventually files the processed electronic document data" as claimed. Ginter adds that "[t]he patent examiner 5064 could also use electronic appliance 600[B] to draft office actions and

notices." (*Id.* ll. 23-24.) Because "[t]he examiner 5064 could communicate these notices and actions via trusted go-between 4700 to the inventor 5060" (*id.* ll. 24-26) we further find that the appliance 600B "provid[es] a response to the client computer via the electronic document filing server, wherein the response includes information related to electronic document data as filed with the receiving agency computer" as claimed. Therefore, we also find that Ginter teaches an agency computer separate from a client computer and an electronic document filing server.

C. TEACHING TOWARD OR AWAY

The Examiner finds, "[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of **Ginter** and **Jecha** to have said electronic document data being entered via a web browser application being executed on said client computer" (Rev. Ans. 5.) He makes the following finding to support his conclusion.

One would have been motivated to do so to allow the system (or administrative user) to define the overall characteristics of a given design of a document via a document template such as HTML [i.e., HyperText Markup Language], such that other users can input information to be formatted in accordance with and/or as allowed by the document template in order to provide a consistent "look" over all the documents

created from a given template, even though all those documents may vary in some ways from one another (**Jecha, paragraph [0044]**).

(Rev. Ans. 5-6.) The Appellants argue that column 20, lines 44-46 of "Ginter teaches that additional software applications must be provided on the sending and receiving computers to accomplish the delivery functions. This teaches away from the concept of using an already installed web browser for communication between a client computer and an electronic document filing server." (Sub. App. Br. 11.) Therefore, the issue is whether the Appellants have shown that Ginter teaches away from using a web browser application to enter data.

"What the prior art teaches and whether it teaches toward or away from the claimed invention . . . is a determination of fact." *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir.1995). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Here, the part of Ginter relied on by the Appellants explains that the reference's "electronic delivery functions can be provided by software integrated with other software applications . . . executing on personal

computer 4116." (Col. 20, ll. 44-46.) We find that such an explanation teaches toward rather than away from integrating the electronic delivery function with other software applications. The reference further explains that "[s]uch delivery . . . may be performed by any convenient electronic means such as, for example, Internet, Electronic Mail or Electronic Mail Attachment, **WEB Page Direct**, . . . or any other electronic means to provide contact with the intended recipient(s)." (Col. 40, ll. 15-22 (emphasis added).) The Examiner's finding that "the Ginter system does implicitly teach about Web browser protocol in order to access WEB page Direct software application" (Rev. Ans. 11) is also uncontested.

Because Ginter teaches integrating its electronic delivery with other software applications and implicitly teaches using a Web browser protocol for delivery, the Appellants have not shown that Ginter teaches away from the use of a web browser application to enter data. Therefore, we affirm the rejection of claim 1 and of claims 2-4, 8-11, and 15-18, which fall therewith.

III. CLAIMS 5-7, 12-14, AND 19-21

Here, the Appellants argue claims 5, 6, 12, 13, 19, and 20, which are subject to the same ground of rejection, as a group. (Sub. App. Br. 12-13). We select claim 5 as the sole claim on which to decide the appeal of the group.

The Examiner finds, "[T]he trusted electronic go-between 4700 of **Ginter** is capable of providing a client computer and/or an applicant computer (*and/or any other authorized party processing the patent application*) with a response related to the electronic document data" (Rev. Ans. 12.) The "Appellants also fail to see the combination of a client computer and an applicant computer." (Reply Br. 6.) Therefore, the issue is whether the combined teachings of Ginter and Jecha would have suggested the combination of a client computer and an applicant computer.

"A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

Here, Ginter's system 4050 also includes an electronic appliance 600A, "such as [a] personal computer[] or computer workstation[]" (Col. 16, ll. 26-27.) Using the electronic appliance 600A "an inventor 5060 might file her patent application 5062 by sending it to the Patent Office 5064" (Col. 57, ll. 55-57.) Claim 1 required "a receiving agency computer **separate** from both the client computer and the electronic document filing server" (Emphasis added.) Claim 5, in contrast, does not require the applicant computer to be "separate"

from the client computer. We find that the electronic appliance 600A would have suggested the combination of a client computer and an applicant computer. Therefore, we affirm the rejection of claim 5 and of claims 6, 12, 13, 19, and 20, which fall therewith.

Although they purport to argue claims 7, 14, and 21 as a separate group (Sub. App. Br. 13-14) the Appellants' argument for the latter claims is tantamount to that for claims 5, 6, 12, 13, 19, and 20, viz., that "the applicant computer, as defined in the claims and specification, is not taught or suggested by the cited art" (*Id.* 14.) Unpersuaded by this argument, we also affirm the rejection of claims 7, 14, and 21.

IV. ORDER

For the aforementioned reasons, we affirm the rejection of claims 1-21 under § 103(a).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2007-3206
Application 09/488,863

AFFIRMED

rwk

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NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

2008-1437
(Serial No. 09/488,863)

IN RE PAUL L. HICKMAN and JAMES J. GOUGH

Glenn E. Von Tersch, Technology & Intellectual Property Strategies Group PC, of Palo Alto, California, argued for appellants.

Nathan K. Kelley, Associate Solicitor, Office of the Solicitor, United States Patent and Trademark Office, of Alexandria, Virginia, argued for the Director of the United States Patent and Trademark Office. With him on the brief were Raymond T. Chen, Solicitor, and Shannon M. Hansen, Associate Solicitor.

Appealed from: United States Patent and Trademark Office
Board of Patent Appeals and Interferences

NO. 2: This disposition is nonprecedent.

United States Court of Appeals for the Federal Circuit

2008-1437
(Serial No. 09/488,863)

IN RE PAUL L. HICKMAN and JAMES J. GOUGH

Judgment

ON APPEAL from the United States Patent and Trademark Office
Board of Patent Appeals and Interferences

in CASE NO(S). 09/488,863

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam (MAYER, PLAGER, and BRYSON, Circuit Judges).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

DATED APR - 3 2009

Jan Horbaly
Jan Horbaly, Clerk

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

APR - 3 2009

JAN HORBALY
CLERK

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

ISSUED AS A MANDATE: MAY 26 2009

By: S. Hill Date: 5/26/09